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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,529	02/24/2004	Donald A. Meltzer	202ES048A	1543
37535	7590	04/06/2006	EXAMINER	
NOVEON IP HOLDINGS CORP. 9911 BRECKSVILLE ROAD CLEVELAND, OH 44141-3247			SERGENT, RABON A	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/785,529	Applicant(s) MELTZER ET AL.	
	Examiner Rabon Sergeant	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 23 January 2006.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-42 is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-42 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/24/04, 12/16/04</u> .	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____.
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1. Applicants' response to the Election of Species requirement of December 19, 2005 is acknowledged.
2. Claims 1-12, 19, 23, 27, 31, and 35-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, the language, "total amount of said polyol", is unclear. It cannot be determined if the language refers only to the polyester polyol or to the combination of the polyester polyol and co-polyol.

Secondly, the language, "a co-chain extender ... of a different chain length", is not understood, because it has not been specified what the co-chain extender is to be compared against. Without a reference point, the language is meaningless. It is unclear if the language of the claims is satisfied by a blend to two symmetrical chain extenders.

Thirdly, the language pertaining to the molar ratio of said co-chain extender to weight percent of said polyether polyol cannot be understood and is therefore essentially meaningless. It is not seen how a molar ratio of a single component (the co-chain extender) can be ascertained or how a molar ratio can be associated with a weight percent, as claimed.

Fourthly, the subject matter of claim 5 fails to further limit the subject matter of the previous claims, since claim 1 contains the same limitation as claim 5.

Fifthly, with respect to claim 37, it is unclear how "substantially" is to further limit "simultaneous reacted". It cannot be determined to what extent "substantially" permits "simultaneous" to not be simultaneous. It would seem that something is either simultaneous or not simultaneous.

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3. Claims 1-12, 19, 23, 27, 31, and 35-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Firstly, applicants have specified a suitable co-chain extender as being of a different chain length; however, applicants have failed to indicate what this co-chain extender or difference is to be compared against. One can only speculate that the co-chain extender is to be compared against the symmetrical chain extender. It cannot be clearly determined if the language, when considered in light of the entire claim, merely allows for the use of a blend of two symmetrical chain extenders.

Secondly, the language pertaining to the molar ratio of said co-chain extender to weight percent of said polyether polyol cannot be understood and is therefore essentially meaningless. It is not seen how a molar ratio of a single component (the co-chain extender) can be ascertained or how a molar ratio can be associated with a weight percent, as claimed. Applicants' specification sets forth no clear definition or guidance as to how this language is to be interpreted.

4. Claims 1-12, 19, 23, 27, 31, and 35-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants have failed to explain or provide guidance with respect to how the molar ratio of said co-chain extender to weight percent of said polyether polyol is determined. As aforementioned, it is not seen how a molar ratio of a single component (the co-chain extender) can be ascertained or how a molar ratio can be associated with a weight percent, as claimed. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

5. Claims 13-18, 20-22, 24-26, 28-30, and 32-34 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for thermoplastic polyurethanes, having the claimed properties, derived from the disclosed reactants in the disclosed amounts according to Examples 2, 3, 5, 9, 10, 12-14, and 16, does not reasonably provide enablement for thermoplastic polyurethanes, having the claimed properties, derived from virtually any polyurethane yielding reactant in virtually any amount. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Except for the aforementioned examples, applicants have failed to provide adequate enablement for the production of thermoplastic polyurethanes having the claimed properties. Without having to resort to undue experimentation, one of ordinary skill in the art could only obtain thermoplastic polyurethanes having applicants' claimed properties by following the teachings of the examples; therefore, the position is taken that applicants' claims should be limited accordingly. It is noted that applicants only discuss the claimed properties in association with the referenced examples and that the specification fails to provide any general guidelines regarding how these properties may be obtained using other than the exemplified reactants in the exemplified amounts; this observation is considered to bolster the examiner's position that one could only arrive at the claimed

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invention by following the examples. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

6. The severity of the issues under 35 U.S.C. 112, first and second paragraphs, preclude further examination on the merits, including further search and consideration of the prior art. Until the aforementioned issues have been addressed, the position is taken that the claims and specification lack the required clarity or degree of precision necessary to permit a meaningful search and application of the prior art.

Any inquiry concerning this communication should be directed to R. Sargent at telephone number (571) 272-1079.


RABON SERGENT
PRIMARY EXAMINER

R. Sargent
April 2, 2006